

**REMARKS**

Applicants appreciate the Examiner's attention to the above referenced application.] Reconsideration of the application is respectfully requested. Claims 1-22 were rejected. Claims 1 and 10-19 have been amended. Claims 1-22 are now pending, of which claims 1, 10 and 19 are independent.

**Objections to the Drawing and Specification**

The Examiner objects to the drawings as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 518 (Figure 5), 910 and 914 (Figure 9). The Specification is amended to add missing reference numerals to the original description, and the typographical error of an incorrect numeral designation is corrected. Therefore, this objection is moot and the drawings do not require correction.

**§ 101 Rejection of the Claims**

Claims 1-22 are rejected under 35 U.S.C. § 101 because:

the claimed invention is directed to non-statutory subject matter: The recitation of the claim 1 and 19, lines 1-2 recites "computer-implemented method correlated to printed material" and the recitation of claim 10, line 2 "machine accessible instruction" could be a carrier wave as stated in the specification and defined as a Carrier Wave (Col.6, [0052]) is a nonstatutory.

Applicants contend that the Examiner has failed to explicitly point to which part of § 101 Claims 1-22 fall under to render them non-statutory. Thus, this rejection is improper and should be withdrawn. Should the Examiner wish to maintain a § 101 rejection, a new non-final Office Action should be prepared where the precise reasoning is given for rejection. However, in an effort to be fully responsive, Applicants make assumptions as to the Examiner's reasoning and herein respond.

Claim 10 and its progeny are amended to more clearly recite the preamble as "*A computer readable storage medium having a plurality of machine accessible instructions stored thereon, wherein when the instructions are executed by a processor, the instructions cause the*

*processor to correlate traditional printed material to a response produced by a computer system by.*” The Specification describes the term “machine readable medium” as including “solid-state memories, optical and magnetic disks, and a *carrier wave* that encodes a data signal.” However, the recitation in the claims of a “computer readable storage medium” clearly limits the claims to an article of manufacture comprising a tangible storage media, as expressly permitted as statutory by *In re Beauregard* (citation omitted). Therefore, the rejection, at least as directed toward Claims 10-18 must be withdrawn.

As for Claims 1-9 and 20-22, it is not at all clear why the Examiner has asserted the subject matter as non-Statutory. The carrier wave reasoning given does not apply to these claims, as they are directed to a statutory category: process (method) and system (apparatus). They are not directed toward a carrier wave medium. Applicants fear that the Examiner has misunderstood the claims and invention, specifically as to the preamble of Claim 1 reciting a “computer-implemented method of correlating printed material...” The method, which is statutory, as a process, is computer-implemented, i.e., not a mental step, the purpose of which, as stated in the preamble, is to correlate printed material to a response produced by a computer system. Thus, the computer system *response* to the printed material produces a tangible and useful result, with the listed technical steps, as recited (defining and linking). Thus, if the Examiner wants to maintain this rejection, a new non-final office action must be provided that explicitly describes why the Claims are non-statutory.

As for Claim 19, a system clearly falls within a category of statutory subject matter, and no exceptions seem to be warranted. Claim 19 is directed toward a “system for associating a selected object on any printed material to a valid response provided by a computer system. Applicants believe that the Examiner saw the phrase “printed material” and jumped to the conclusion that anything involving printed material cannot be patented. This assumption, if made, is ludicrous. Claims 19-22 are directed toward a system for associating a selected object to a response of a computer system. Thus, there is a technological component; it is implemented on a device; and it is not directed to mere printed material or a mental step. As with Claims 1-9, this rejection is improper and vague. Thus, if the Examiner wants to maintain this rejection, a new non-final office action must be provided that explicitly describes why the Claims are non-statutory.

### **§102 Rejection of the Claims**

Claims 1-5, 8-14, and 17-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ohara et al. (Us Patent No. 5739814). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

The Examiner has misunderstood an important aspect of Applicants' invention. The Examiner cites Ohara as prior art. However, Ohara is directed to an electronic book. The pages of the book are permanently fixed to a computer system and pointing device, keys or other input device. This electronic book may have several programs installed so that interaction with the book, by a user, may take on a variety of scenarios. In contrast, the claimed invention is directed toward linking objects in traditional printed material, most often paper, with a set of responses to be performed by a computer system. Thus, Applicants' invention allows a user to link many different books with many different multimedia responses via the same system.

Claims 1 and 10 have been amended to recite that the printed material is "traditional printed material," i.e., a paper book, brochure, pamphlet, magazine, etc. Further, Claims 1, 10 and 19 have been amended to explicitly recite that the printed material is not directly or communicatively coupled to the computer system. Thus, this, at least, distinguishes the claimed invention from the cited electronic book. An electronic book, by definition, has pages coupled to the device containing a processor. Moreover, the claims are further amended to more clearly recite that the position on the page is defined by a relative position of the traditional printed material to a known physical location of a printed material holder. In other words, the printed material in the present invention is placed in the printed material holder before defining objects on the page. The printed material holder keeps the printed material in a fixed location with respect to the holder, so that a user may define a location within a page. Any printed material may be placed in the holder and linked to computer system responses, and is not limited to pre-fixed pages, as in an electronic book. These features are not taught or suggested by the cited reference. Thus, the rejection should be withdrawn.

**§103 Rejection of the Claims**

Claims 6-7 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara et al. (US Patent No. 5739814). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

Once again, the Examiner confuses the electronic book system with the claimed system and method for linking objects of traditional printed material. This rejection is believed moot based on the above amendments and discussion.

All claims remaining in the application are now allowable.

**CONCLUSION**

Applicants respectfully request reconsideration in view of the remarks and amendments set forth above. If the Examiner has any questions, the Examiner is encouraged to contact the undersigned at **703-633-6845**. Please charge any shortage of fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-0221 and please credit any excess fees to such account.

Respectfully submitted,

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